

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **William M. Andre**

Serial No. 10/765,287

Filed: January 27, 2004

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For: Workpiece Holder

Group Art Unit: 3722

Examiner: Dana Ross

In reply to: Examiner's Letter of April 11, 2007

PRE-APPEAL BRIEF CONFERENCE REQUEST FOR REVIEW

This request is being filed with a Notice of Appeal and is being filed in view of clear errors in the Final Office Action mailed June 4, 2007, in which claims 1-7, 9-17, and 19-25 were rejected under 35 USC §§ 102 and/or 103. Applicants request review of the subject application by a Panel of Examiners under the authority of the New Pre-Appeal Brief Conference Program,¹ and the Extension of the Pilot Pre-Appeal Brief Conference Program.²

The clear errors are in the interpretation of the claims and of the applied references. The Examiner's comments in the Final Office Action indicate that she has not properly interpreted or understood the meaning of the claim terminology and the applied references and, as a result, has made a clearly erroneous determination of the novelty and patentability of the subject matter of the claims in view of those references.

The first issue that should be corrected without the need for Board review and action is the Examiner's interpretation of the meaning of claims 1 and 22. Claims 1 and 22 recite, *inter alia*, at least one drive member carried by a body, wherein a fluid chamber

¹ 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)
(<http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>).

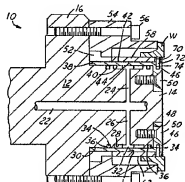
² 1303 Off. Gaz. Pat. Office 21 (February 7, 2006)
(www.uspto.gov/web/offices/com/sol/og/2006/week06/patexcf.htm).

is at least partially defined therebetween. With regard to this claim language, and referring to a bladder ring 45 (“diaphragm, drive member”) and a base 12 (“body 12”) of the Mueller ‘376 reference, the Examiner stated:

“Examiner notes there is no limitation in the claims that the fluid chamber be defined between the bladder ring and the base.” (Final Office Action, page 11)

Clearly, the Examiner has erroneously overlooked Applicants’ claimed limitation of a fluid chamber at least partially defined between a body and at least one drive member carried by that body.

The second issue that should be corrected without the need for Board review and action is the Examiner’s interpretation of the meaning of claims 1, 11, and 22. Claims 1, 11, and 22 recite, *inter alia*, a workholding apparatus body, and at least one drive member having an annular flange portion attached to at least a portion of the body to resist rotation of the at least one drive member relative to the body. (example below)



Applicants' Fig. 1

With regard to this claim language, and referring only in general to the applied references, the Examiner asserted the following:

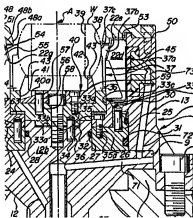
“Examiner further notes that a ‘portion’ of the annular flange is axially abutting and attached to at least a ‘portion’ of the body. The annular flange of the diaphragm is connected with various body ‘portions’, as a minimum as a way to hold the parts of the holder together.” (Final Office Action, page 11)

“Examiner further notes that the body of the workholding apparatus is connected directly with the diaphragm 45.” (Final Office Action, page 15, referring to Mueller ‘376)

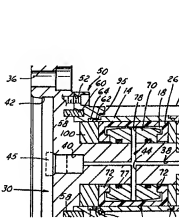
“Examiner further notes that...the diaphragms taught in the prior art are ‘attached’ to the body in accordance with Applicant’s understanding of the definition of ‘attach’...” (Final Office Action, pages 16-17).

“...the prior art teaches (and shows in the drawings) the annular flange portions of the drive member (diaphragm, bladder, expandable ring) axially abutting and attached to at least a portion of the body, as claimed. Applicant is referred to the above rejections, and Figures 1 of each reference for the reference numbers cited as to the claim limitations.” (Final Office Action, page 21).

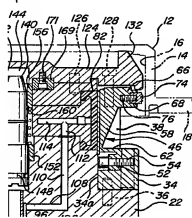
But, despite several opportunities to do so, the Examiner failed to particularly reinforce these unsupported assertions, such as by using specific reference numerals in the drawings, or by reference to column and line numbers of the descriptions, of the prior art references. For example, precisely where is an annular flange portion of a drive member attached to at least a portion of a body in the applied references? How? Why? Such failures to provide specific support arise because the prior art drive members (bladder ring 45, ring 26, bladder ring 82) are merely carried on and are NOT attached³ to their respective retainers (ring support 44, retainer 70, or retainer ring 78), and certainly not to their bodies (body 12, main body 30, body 22), and definitely not for the purpose of resisting rotation of the drive members.



Mueller '376



Andre '154



Mueller '284

³ The term “attach” means to fasten on or affix to; connect or join. See *Ex Parte McCarthy*, 2004 WL 697002 (BPAI 2004) (a seal flange is not affixed to an annular cover by spring force, because pressing action of a spring does not fasten, connect or join the annular cover and the flange.)

Also, the Examiner states that mere expansion and engagement of the diaphragm 26 of Andre resists rotation relative to the body. But Applicants point out that Andre was cited in the Applicants' Background section, for example, because such prior art workholders – including the Mueller workholders – are not capable of sufficiently resisting such rotation in high performance applications under high cutting force conditions and, in fact, such prior art drive members can rotate relative to their respective retainers precisely because they are not attached thereto but are only merely carried thereon. Again, nowhere has the Examiner shown where the applied references describe or show a drive member attached to its respective retainer, much less attached to the body of the workholding apparatus, and far less for the purpose of resisting rotation.

Incidentally, the Examiner states that "...there is no claimed limitations in the claims for 'a drive member annular flange attached to a body'." (Final Office Action, page 16) Applicants concede that the precise form of that language is not set forth in the claims, but Applicants' claims do clearly recite "an annular flange portion...attached to at least a portion of the body..." The Examiner's argument appears to be one of form over substance.

Also, the Examiner broadly mischaracterizes the term "body" of a workholding apparatus to include numerous components other than a workholder body. In a first example, the Examiner asserted on page 15 of the Final Office Action that:

"In the cited prior art, the 'body' includes the base, sides, and general structure of the workholding apparatus."

But those of ordinary skill in the art know that a workholding apparatus "body" does not include such a broad scope and certainly not some indeterminate "general structure." Besides, this assertion clearly contradicts the Examiner's earlier interpretation of each prior art body found on pages 3 through 6, as follows:

"...U.S. Patent No. 5,429,376 to Mueller et al....discloses...a body (12);" (page 3) "Examiner notes that those familiar with tool holders will understand that reference to reference number '12' is a reference to the 'body' of Mueller's invention..." (page 4)

"...U.S. Patent No. 6,015,154 to Andre et al....discloses...a body (30);" (page 5)

“...U.S. Patent No. 5,441,284 to Mueller et al....discloses...a body (22);” (page 6)

In a second example, the Examiner further asserted on page 15 of the Final Office Action that:

“It is further noted, that the claimed diaphragm is part of the body of the workholding apparatus.”

But such an interpretation is incorrect because Applicants separately claim both a workholding apparatus body and a drive member, wherein the drive member is carried on the body. So how can Applicants’ drive member be part of the separate body, and how can the drive member be carried on itself? It clearly cannot be and the Examiner’s interpretations are, thus, clearly erroneous.

Having not fully understood the meaning of Applicants’ claims and of the applied references, it is apparent that the Examiner has clearly failed to set forth even *prima facie* rejections under §§ 102 and 103 and, thus, has erroneously concluded that the subject matter of the claims is anticipated or rendered obvious by the prior art. These conclusions are clearly wrong and should be overturned without the need for Board review and action. Therefore, reconsideration and withdrawal of one or more of the §§ 102 and 103 rejections, and allowance of at least one of independent claims 1, 11, or 22 is respectfully requested.

It is hereby authorized and respectfully requested that any deficiency in fees be charged to our Deposit Account No. 50-0852.

Respectfully submitted,

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Filed Via EFS Only
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WHF/SBW

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